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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/802,634

Filing Date: March 09, 2001

Appellant(s): SHMUELI ET AL.

Taylor M. Davenport
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/18/2007 appealing from the Office action
mailed 3/8/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Board of Appeal decision #2006-0989, mailed 3/28/2006.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5884271	Pitroda	03-1999
6950857	Arnold	09-2005
20030014371	TURGEON	01-2003
6199077	Inala et al	03-2001
20020029254	Davis et al	03-2002
6385729	DiGiorgio et al	5/2002
5633843	Gupta et al	5-1997
20040205155	Nobakht	10-2004

Davis et al. provisional application #60/230,404 (dated September 6, 2000) to application 09/946,220 which resulted in US PGPUB 20020029254.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the

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responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,6,7,9-15,18,19,21-23,26 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,884,271) in view of Arnold (US 6,950,857), in view of TURGEON (US 2003/0014371) and further in view of Official Notice.

In regards to claim 1, Pitroda discloses a portable device comprising:

a body (FIG 1);

memory within the body containing software and financial account information (FIG 3);

an interface associated with the memory and adapted to facilitate interaction with a host computing device during a computing session (FIG 30, col 10, lines 40-45);

the software adapted to execute on the host computing device to instruct the host computing device (col 10, lines 40-50 and FIG 4) to:

Pitroda teaches the use of stored financial information on a UET to conduct a transaction over the internet (FIG 2) and also teaches programming the portable device for special application. Pitroda does not however specifically mention that the financial fields of a web page are recognized and financial fields are filled in during the web based transaction. Arnold teaches using an ancillary computing device to analyze web page fields and fill in the appropriate fields. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include auto fill functionality within the UET for the obvious reason that auto form filling saves time and is more accurate than manual filling of forms.

automatically execute on the host computing device in association with the computing session (FIG 4, initialization and I/O drivers, item 419 & 422). Applicant may argue, however, that Pitroda does not specifically mention auto execution on the PC. As stated in applicant's specification (page 6, line 30 – page 7, line 15) auto run capability is old and well known in the art, the examiner additionally takes official notice that automatically executing a remote device on a host device is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Pitroda an auto-execute program because this will simplify

the accessing of the remote application by not requiring the devices application to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device, and

Pitroda teaches secure transactions over the internet via a PC, but does not specifically mention that residual data is flushed from the client PC. TURGEON teaches flushing the PC memory to remove data after use in a transaction (FIG 5, item 521). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Pitroda erasing the memory in the client PC, because this will improve the security of sensitive data by not allowing the data to reside on a device that is not secure.

In regards to claim 2, Pitroda teaches wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

- query a user to select one of the plurality of financial accounts (FIG 4);
- receive selected indicia from the user (FIG 13); and

- fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (FIG 16).

In regards to claim 3, Pitroda teaches wherein the software is further adapted to provide an authentication routine to execute on the host computing device,

the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device (FIG 11) and

determine if the authentication indicia received from the user matches authentication indicia stored on the portable device (col 14, lines 7-18).

In regards to claims 6 and 7, Petridis teach the data filling objects in regards to financial data (see claims 1 and 2 above), but does not specifically mention that the data being processed is shipping information. Since the limitation of shipping information does not impart any functionality this limitation is considered to be non-functional descriptive material (see MPEP 2106(b)) and is therefore not considered to provide patentable distinction. The examiner contends that the system would work equally well with the auto filling of any type of data.

In regards to claim 9, Pitroda teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device (FIG 4).

In regards to claim 10, Pitroda teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 4).

In regards to claim 11, Pitroda teaches wherein the interface is adapted to directly interface a port in the host computing device (UET and CIU).

In regards to claim 12, Pitroda teaches wherein the interface is adapted to provide a wireless interface with the host computing device (col 10, lines 4-25).

Claims 4,5,16,17,24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,884,271) in view of TERGEON (US 20020029254) in view of Inala (US 6,199,077) and further in view of Official Notice.

In regards to claim 4, Pitroda teaches storing applications on a portable device that can be activated on a PC, but does not specifically mention that the application is one that activates an auto login to a second web page. Inala teaches an auto login feature (FIG 5). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Pitroda an application for auto logging because this would save the user time and provide a automatic and transparent access to restricted websites to the user.

In regards to claim 5, the combination of Pitroda/Inala teaches wherein a bookmark for the web page is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing to make the bookmark accessible by the browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser (Inala, col 8, lines 15-30).

In regards to claims 13-19 and 21-27, these claims are considered to be parallel claims to claims 1-8 and are rejected for the same rationale.

Second 103 Rejection

The examiner in an effort to map for the applicant all the best art cited is also providing the following rejection in view of Davis.

Claims 1-7,9-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 20020029254) in view of Arnold, in view of TERGEON and further in view of Official Notice.

In regards to claim 1, Davis discloses a portable device comprising:
a body (FIG 4, item 410);
memory within the body containing software and financial account information (para 0036);
an interface associated with the memory and adapted to facilitate interaction with a host computing device during a computing session (FIG 7);
the software adapted to execute on the host computing device to instruct the host

computing device (para 0036) to:

Davis teaches the use of wallet applications on a smart card with server like functionality to conduct transactions over the internet (FIG 5) and also teaches processing applications from the smart card on a client device (para 0043) along with functionality to populate a vendor site with credit card information (para 0059). Davis does not however, specifically mention that the financial fields of a web page are recognized and financial fields are filled in during the web based transaction. Arnold teaches using a ancillary computing device to analyze web page fields and fill in the appropriate fields. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include auto fill functionality in Davis's smart card for the obvious reason that auto form filling saves time and is more accurate than manual filling of forms.

Davis teaches the use of multiple user applications (para 0031) but does not specifically mention auto execution on the PC. As stated in applicant's specification (page 6, line 30 – page 7, line 15) auto run capability is old and well known in the art, the examiner additionally takes official notice that automatically executing a remote device on a host device is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis an auto-execute application on the server like smart card of Davis, because this will simplify the accessing of the remote application by not requiring the device to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device. and

Davis teaches secure transactions over the internet via a PC, but does not specifically mention that residual data is flushed from the client PC. TUGREON teaches flushing the PC memory to remove data after use in a transaction (FIG 5, item 521). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Davis erasing the memory in the client PC, because this will improve the security of sensitive data by not allowing the data to reside on a device that is not secure or will be usable by another at a latter time.

In regards to claim 2, Davis teaches wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

query a user to select one of the plurality of financial accounts (FIG 8C);
receive selected indicia from the user (FIG 8C); and

fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (see response to claim 1).

In regards to claim 3, Davis teaches server like functionality on a smart card, the use of passwords to access applications and the further use of a password to access critical data (FIG 8B), but does not specifically mention that the access to the

smart card is controlled by an authentication routine. The examiner takes official notice that the use of authentication routines to access secure information was old and well known in the art at the time of the instant invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis an authentication routine, because this would assure that only users authorized access to the secure information are permitted to access and use the secure information from the smart card.

In regards to claim 4, Davis teaches wherein the portable device stores login information for a second web page associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the second web page and provide the login information upon entering the second web page (para 0060).

In regards to claim 5, Davis teaches wherein a bookmark for the web page is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing to make the bookmark accessible by the browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser (FIG 8B).

In regards to claim 6, Davis teaches within the portable device stores shipping information for a item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web page to facilitate delivery of the item selected for purchase (FIG 8A).

In regards to claim 7, Davis teaches wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

query a user to select one of the plurality of shipping addresses ;
receive selection indicia from the user (FIG 8D); and
fill in the shipping address fields with certain of the shipping information
corresponding to the selected one of the plurality of shipping addresses See
response to claim 1).

Further, in regards to claims 6 and 7, Davis teaches the data filling objects in regards to financial data (see claims 1 and 2 above), but does not specifically mention that the data being processed is shipping information. Since the limitation of shipping information does not impart any functionality this limitation is considered to be non-functional descriptive material (see MPEP 2106(b) and is therefore not considered to provide patentable distinction. The examiner contends that the system would work equally well with the auto filling of any type of data.

In regards to claim 9, Davis teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device (FIG 8A).

In regards to claim 10, Davis teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 8A).

In regards to claim 11, Davis teaches accessing a client device using a smart card accepting device (para 0031).

In regards to claim 12, Davis teaches accessing a client device, but does not specifically mention that the client is accessed wirelessly. The examiner takes Official Notice that it was old and well known in the art at the time of the invention to use wireless technology to access client devices. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis, wireless technology, because this would offer another means of accessing a client device that might only have wireless access capability, thus incorporating this technology in the smart card would increase the usefulness of the Davis system and increase sales.

In regards to claims 13-19 and 21-27, these claims are considered to be parallel claims to claims 1-8 and are rejected for the same rationale.

As an initial matter, the examiner agrees with applicant's assessment of the references in the first rejection as is presented on page 8 last paragraph of the reply.

Response to Arguments

Applicant's arguments filed 12/15/2006 have been fully considered but they are not persuasive.

Pitroda Rejection

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Applicant argues that Pitroda does not teach the examiner disagrees and further directs the applicant's attention to col 11, lines 58-67, and the discussion of software being stored for use on the UET.

Applicant argues that the UET does not instruct the host computer to do anything the examiner disagrees and directs the applicant's attention to (col 12, lines 33-36), where it is clear that the UET carries many software programs that interact with the host PC to display information in a particular format.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The applicant appears to argue that the software that provides functionality resides

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exclusively on the portable device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In regards to this argument, the "software instruct the host computing device" merely implies that a signal is provided from the device to execute software that is present on the host. This is evident in the auto execute feature of the instant invention where plug and play technology is used. As is well known in the art, the plug and play software is resident on the host and auto execute merely by recognizing the device or an indication of the type of information that is present on the portable device.

Applicant argues that Arnold teaches a Robot that is not present on the portable device and therefore teaches away from instant invention. The examiner disagrees and notes that this is not the part of the teaching in Arnold that is relevant. The relevant part is the software that is resident on the portable device that places the information that is retrieved by the robot into the form on the laptop. Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Arnold. Further, Arnold discloses the use of a form filling software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has used knowledge that was generally available in the art to show motivation for including auto run capability, however, since applicant appears to be arguing the factual nature of the motivation the examiner provides US 5,633,843 to Gupta et al see col 4, 20-30 as support for the motivation provided.

Applicant's argues that the combination of Pitroda with an auto run capability would unsatisfactory for its intended purpose. The examiner disagrees and notes that the UET must interact with the host and different drivers need to be executed on the host, therefore, auto execute would be desirable to automatically execute this software and quickly provide a session to the user.

Applicant argues that the code for erasing the records is not on the portable device. The examiner agrees that the code is apparently not from the portable device of TURGEON., however, Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of TURGEON. Further, TURGEON discloses the use of PC memory flush function software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Applicant argues that the combination of Pitroda and TURGEON does not teach "in association with the termination of the computing session" the records are removed. The examiner disagrees and directs applicant's attention to item 514, which ends the interactive session with the portable device and initiates the request for the e-pin and transfer to the web server. Once the consumer enters the e-pin the data is automatically erased from the memory. Therefore the termination of the interactive session between the host and the portable device is clearly associated with the flushing of the memory.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge of one of ordinary skill in the art is applied. Applicant appears to be asking for a reference that supports the motivation. For this purpose Nobakht (US PG PUB 20040205155) is provided. The applicant is directed to paragraphs 0009 and 0064 for support of the security related erasure.

Applicant argues that Pitroda does not need additional security since the UET includes security features. The examiner disagrees and notes that in order for the PC to process the data the information has to be stored at least in temporary memory for the processor to process the data, therefore private information is transferred so additional erasure for security purposes would be needed to assure that secure data is not compromised.

Applicant argues that the data would be needed for a period of time to do the analysis. The examiner notes that this is but one embodiment and does not represent all the situations such as POS terminal or ATMs for example. Regardless, the use of the computation functions does not present a length of time associated with the transactions and as stated in TURGEON, "First and foremost is the issue of security. Fraud in transactions may cost Web merchants many thousands of dollars in lost revenues. Furthermore, to do on-line purchases without any reservations, customers need to feel safe and assured that their confidential information will not be intercepted and misused by fraudulent users or by an unscrupulous merchant" Further, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues the motivation provided in the previous office action regarding Inala. The examiner further directs applicant's attention to col 1, lines 45-60 of Inala for the following motivation explaining the problem to be solved "One problem that is encountered by an individual who has several or many such subscriptions to Internet-

brokered services is that there are invariably many passwords and/or log-in codes to be used. Often a same password or code cannot be used for every service, as the password or code may already be taken by another user. A user may not wish to supply a code unique to the user such as perhaps a social security number because of security issues, including quality of security that may vary from service to service. Additionally, many users at their own volition may choose different passwords for different sites so as to have increased security, which in fact also increases the number of passwords a user may have".

Applicant argues that the combination of Pitroda/Arnold/TURGEON/Official Notice and Inala does not teach wherein the portable device stores login information for a web site associated with the web passed transaction. The examiner disagrees and further directs the applicant's attention to Inala col 6, line 64 – col 7, line 10.

Applicant argues that the code for auto-login is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of auto-login function software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse, 86 USPQ 70.*

Applicant argues that the combination of Pitroda and Inala does not teach the use of Bookmarks. The examiner disagrees and refers the applicant to the col 8, lines 25-41 of Inala, which was referenced in the last office action.

Applicant argues that the code for establishing bookmarks is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of a book mark function software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse, 86 USPQ 70.*

Response to Davis Rejection

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The applicant appears to argue that the software that provides functionality resides exclusively on the portable device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)*. In regards to this argument, the "software instruct the host computing device" merely implies that a signal is provided from the device to execute software that is present on the host. This is evident in the auto execute feature of the instant invention

where plug and play technology is used. As is well known in the art, the plug and play software is resident on the host and auto execute merely by recognizing the device or an indication of the type of information that is present on the portable device.

Applicant argues that the applications on the smart card act locally and do not execute on the host to instruct the host to perform the steps of the instant claims. The examiner disagrees and notes that it is inherent that a application that is operated on a secondary device such as when a smart card executes on a PC, must use the PC to execute the application in order to have the PC function.

Applicant argues that Arnold teaches a Robot that is not present on the portable device and therefore teaches away from instant invention. The examiner disagrees and notes that this is not the part of the teaching in Arnold that is relevant. The relevant part is the software that is resident on the portable devise that places the information that is retrieved by the robot into the form on the laptop. Davis' smart card is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Arnold. Further, Arnold discloses the use of a form filling software except for the software being on the smart card. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the smart card, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse, 86 USPQ 70.*

Applicant argues the motivation for combining auto run capability. To provided evidence of this motivation that it is an efficient manner of starting a program, DiGiorgio is introduced and applicant is directed to col 2, lines 24-34, where it is stated that "The secure token device may hold identification information that is globally unique across geographic and political boundaries. This identification information is held securely on the secure token device. It is difficult for a party to physically access the identification information. The secure token device serves as a physical token of authenticity for the party. In order to fraudulently use the secure token device, a party must both physically take the secure token device and also be aware of the PIN associated with the user of the secure token device. Hence, the use of the secure token device helps to decrease the probability of fraud.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)* and *In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)*. In this case, the examiner has used knowledge that was generally available in the art to show motivation for including auto run capability, however, since applicant appears to be arguing the factual nature of the motivation the examiner provides US 5,633,843 to Gupta et al see col 4, 20-30 as support for the motivation provided.

Applicant's argues that the combination of Davis with an auto run capability would unsatisfactory for its intended purpose. The examiner disagrees and notes that the smart card must interact with the host and different drivers need to be executed on the host, therefore, auto execute would be desirable to automatically execute this software and quickly provide a session to the user.

Applicant argues that that there is no support for the combination of Davis and TURGEON in regards to erasing the information for security reasons. The examiner directs the applicant's attention to the following statement in TURGEON (para 004), "First and foremost is the issue of security. Fraud in transactions may cost Web merchants many thousands of dollars in lost revenues. Furthermore, to do on-line purchases without any reservations, customers need to feel safe and assured that their confidential information will not be intercepted and misused by fraudulent users or by an unscrupulous merchant" Further, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the combination of Pitroda/Arnold/TURGEON/Official Notice and Inala does not teach wherein the portable device stores login information for a web site associated with the web passed transaction. The examiner disagrees and further directs the applicant's attention to Inala col 6, line 64 – col 7, line 10.

Applicant argues that the code for auto-login is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Davis' smart card is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of auto-login function software except for the software being on the smart card. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the smart card, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Applicant argues that the combination of Davis and Inala does not teach the use of Bookmarks. The examiner disagrees and refers the applicant to the col 8, lines 25-41 of Inala, which was referenced in the last office action.

Applicant argues that the code for establishing bookmarks is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Davis is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of a book mark function software except for the software being on the smart card. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the smart card, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

(10) Response to Argument

7A. Appellant argues that the Patent Office has failed to provide an apparent reason why one of ordinary skill in that art would combine the references in the manner asserted by the patent office. It is noted that all of the elements of the cited references perform the same function when combined as it does in the prior art. Thus such a combination would have yielded predictable results (see *Sakraida*, 425 US at 282, 189 USPQ at 453. Since the independent claims recited only unit old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of the references is drawn to methods of conducting transactions over the internet.

7B. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7C. Appellant argues that the Patent Office has failed to provide an apparent reason why one of ordinary skill in that art would combine the references in the manner asserted by the patent office. It is noted that all of the elements of the cited references perform the same function when combined as it does in the prior art. Thus such a combination would have yielded predictable results (see *Sakraida*, 425 US at 282, 189 USPQ at 453. Since the independent claims recited only unite old elements with no change in their respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of the references is drawn to methods of conducting transactions over the internet.

7D. - In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

7D1 – Appellant argues that Pitroda does not teach the specific software instructions that perform features i –iv. The examiner agrees and notes that the examiner used Pitroda to teach the well known nature of portable devices carrying software instructions along with financial data. The examiner noted that the specific instructions were taught in alternative cited references. The examiner also directs the applicant's attention to para 10, lines 20 through 25 of Pitroda that teaches that "some of the features of the CIU may be incorporated directly into the UET card provided the size of the card can remain small enough to carry it in the pocket". Further it is clear that the CIU contains software (FIG 7) that causes the pc/pos to operate as needed (col 13, lines 1-10).

7D2 – As stated in the previous office action and as restated here, Appellant argues that Arnold teaches a Robot that is not present on the portable device and therefore teaches away from instant invention. The examiner disagrees and notes that this is not the part of the teaching in Arnold that is relevant. The relevant part is the

software that is resident on the portable device that places the information that is retrieved by the robot into the form on the laptop. Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Arnold. Further, Arnold discloses the use of a form filling software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In response to appellant's arguments that Arnold teaches away from appellant's invention by attacking Arnold individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7D3.– In regards to appellant's argument that Pitroda in view of official notice does not teach an auto execute function. It is noted that appellant does not argue that Pitroda does not teach auto-execute in FIG 4, I/O drivers and (Item 419 and 422) see page 4, line 4 of the previous office action. Appellant did not traverse the initial taking of official notice in the 10/19/2006 office action and only argued the motivation of the combination in the 12/15/2006 office action. The examiner notes that a "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that

would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning gleaned from applicant's specification, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d

1392, 170 USPQ 209 (CCPA 1971). It is further noted that appellant is not arguing the feature, which the examiner has taken official notice but only the motivation.

As stated in the office action mailed 3/8/2007 "In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has used knowledge that was generally available in the art to show motivation for including auto run capability, however, since applicant appeared to be arguing the factual nature of the motivation the examiner provides US 5,633,843 to Gupta et al see col 4, 20-30 as support for the motivation provided". Appellant has neglected to argue these findings as well.

Further it is noted that all of the elements of the cited references performs the same function when combined as it does in the prior art. Thus such a combination would have yielded predictable results (see *Sakraida*, 425 US at 282, 189 USPQ at 453. Since the independent claims recited only unites old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

7D4 – Appellant argues that the combination and specifically Turgeon does not teach removing records from the host in association with the termination of the

computing session. As previously argued by the examiner in the 3/7/2007 office action Appellant "... argues that the data would be needed for a period of time to do the analysis. The examiner notes that this is but one embodiment and does not represent all the situations such as POS terminal or ATMs for example. Regardless, the use of the computation functions does not present a length of time associated with the transactions and as stated in TURGEON, "First and foremost is the issue of security. Fraud in transactions may cost Web merchants many thousands of dollars in lost revenues. Furthermore, to do on-line purchases without any reservations, customers need to feel safe and assured that their confidential information will not be intercepted and misused by fraudulent users or by an unscrupulous merchant" Further, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)".

7E – The examiner acknowledges appellant's recollection of an interview conducted on 9/26/2006, but does not recall the specifics only that Davis was discussed and that no agreement had been reached.

7E1- Applicant argues that Davis does not teach applications executing on the host computer and seems to elude that the provisional application to Davis does not teach this feature. The examiner disagrees and directs the appellant's attention to provisional application 60/230,404, FIG 1 (smart card commands) and page 5, lines 14

and 15 (smart card server function) as further teachings of the smart card executing application on a host device.

7E2 - As stated in the previous office action and as restated here, Appellant "...argues that Arnold teaches a Robot that is not present on the portable device and therefore teaches away from instant invention. The examiner disagrees and notes that this is not the part of the teaching in Arnold that is relevant. The relevant part is the software that is resident on the portable devise that places the information that is retrieved by the robot into the form on the laptop. Davis' smart card is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Arnold. Further, Arnold discloses the use of a form filling software except for the software being on the smart card. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the Smart card, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70".

In response to appellant's arguments that Arnold teaches away from appellant's invention by attacking Arnold individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As stated in the office action mailed 3/8/2007, Appellant "... argues the motivation for combining auto run capability. To provided evidence of this motivation that it is an efficient manner of starting a program, DiGiorgio is introduced and applicant

is directed to col 2, lines 24-34, where it is stated that "The secure token device may hold identification information that is globally unique across geographic and political boundaries. This identification information is held securely on the secure token device. It is difficult for a party to physically access the identification information. The secure token device serves as a physical token of authenticity for the party. In order to fraudulently use the secure token device, a party must both physically take the secure token device and also be aware of the PIN associated with the user of the secure token device. Hence, the use of the secure token device helps to decrease the probability of fraud".

7E3 - In regards to appellant's argument that Davis in view of official notice does not teach an auto execute function. It is noted that appellant does not argue that Davis does not teach auto-execute in FIG 4, I/O drivers and (Item 419 and 422) see page 4, line 4 of the previous office action. Appellant did not traverse the initial taking of official notice in the 10/19/2006 office action and only argued the motivation of the combination in the 12/15/2006 office action. The examiner notes that a "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that appellant's arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments

do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

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In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning gleaned from applicant's specification, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is further noted that appellant is not arguing the feature, which the examiner has taken official notice but only the motivation.

As stated in the office action mailed 3/8/2007 "In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has used knowledge that was generally available in the art to show motivation for including auto run capability, however, since applicant appears to be arguing the factual nature of the motivation the examiner provides US 5,633,843 to Gupta et al see col 4, 20-30 as support for the motivation provided". Appellant has neglected to argue these findings as well".

Further it is noted that all of the elements of the cited references performs the same function when combined as it does in the prior art. Thus such a combination would have yielded predictable results (see *Sakraida*, 425 US at 282, 189 USPQ at 453. Since the independent claims recited only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

7F as previously argued by the examiner in office action mailed 3/8/2007, Appellant "... argues that the combination of Pitroda and Inala does not teach the use of

Bookmarks. The examiner disagrees and refers the applicant to the col 8, lines 25-41 of Inala, which was referenced in the last office action.

Applicant argues that the code for establishing bookmarks is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of a book mark function software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse, 86 USPQ 70*".

Appellant argues that the Patent Office has failed to provide an apparent reason why one of ordinary skill in that art would combine the references in the manner asserted by the Patent Office. It is noted that all of the elements of the cited references performs the same function when combined as it does in the prior art. Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims recited only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of the references are drawn to methods of conducting transactions over the internet.

In regards to appellant's argument that Inala does not teach an auto logging the examiner once again directs the appellant to Inala Fig 5, item 105 (auto login).

In conclusion and as a separate argument the appellant places heavy weight on the software executing on the host computing device and argues that Davis and Pitroda do not teach this feature. The examiner notes that it is well established and known to an artisan in the art that when an application is operated on a secondary device such as when a smart card executes on a PC, the PC must execute at least a portion of the application instructions in order to have the PC function.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Fadok

Primary Examiner

Conferees:



Jeffrey Smith

SPE AU 3625



Vincent Millin

Appeals Specialist